

## REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments mentioned below.

### Rejection of claims 1, 3-4, 6-7, 11, and 18 under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim and Handbook of Cosmetic Science)

Applicants respectfully suggest that the motivation to combine the references do not make out a prima facie case of obviousness. This is because the combined teachings provide, at most, an obvious to try motivation. The references do not suggest that the claimed method would be reasonably expected to succeed, because the proposed modification of the claimed method would not be made apparent to those of ordinary skill in the art for the following reasons listed below.

1. Anderle and Kim

Anderle discloses methods of preparing water dispersible and/or soluble polyurethanes ("wsPUs"). In addition, he discloses a sunscreen lotion in Example 24. Although the exact nature of the lotion is not specifically disclosed, it appears to have emulsifiers and at least one hydrophobic UV block – octyl salicylate.

It is respectfully suggested that Anderle's composition is opposite in nature to Kim's, whose compositions (i) are all soluble solutions as opposed to multiphasic compositions; (ii) they do not disclose the addition of any sunscreens. Nor does Anderle disclose the desirability of adding sunscreens to his solutions. Thus, although these

references may, arguably, be viewed as being derived from analogous art, their teachings are very different.

Kim is cited for disclosing wsPUs and the particular diols previously recited in amended claim 1. (Note: the limitation directed to the specific diols has been deleted. However, dependent claims 11 and 18 recite these diols.) However, Kim discloses and exemplifies only solutions containing wsPUs. See table in col. 8. All of the exemplified embodiments are aqueous solutions or aqueous-ethanolic solutions. Respectfully, there is no rationale for Examiner's conclusion that wsPUs actually function as an effective ingredient in any multiphasic system, i.e., Anderle's lotion and the instantly claimed method that employs the recited O/W formulations.

Kim also does not disclose a combination of wsPUs with a sunscreen. Therefore, it would appear that Kim would not motivate persons in the art to combine it with either Anderle, and/or as discussed below, Stein.

Additional support for this conclusion is that Kim discloses that in cases where the wsPUs may not be completely soluble, the resulting composition would be a microdispersion that "*do not as a rule require emulsifiers or surfactants to stabilize them.*" Col. 6, lines 1-7. When considering that the claimed O/W formulations clearly require an emulsifier in addition to other hydrophobic components, it would very likely be apparent that these references would not be conceptually combined by those of

ordinary skill. This would be just as true for Stein, which Examiner cited for teaching the combination of sunscreens and O/W emulsions.

It is respectfully suggested that Examiner's proposed modification of Anderle's composition with Kim's wsPUs and Stein's sunscreens would rise to only an obvious to try level of motivation, which is known to not be sufficient for a prima facie case of obviousness. It is respectfully suggested that the Examiner still has not also explained specifically how one of ordinary skill in the art would be motivated to combine all these references together to practice the claimed invention given that there are probably hundreds or thousands of different compounds which can be formed into a formulation for personal care application use.

## 2. Hindsight

It is also respectfully suggested that Examiner's motivation to combine Anderle, Kim and Stein was based on her knowledge of the composition required in the claimed method. For example, nowhere does Stein suggest that his O/W compositions should be more water dispersible, nor that wsPUs would be useful for any purpose. Similarly, nowhere does Anderle teach or disclose that O/W formulations would be a desirable or preferred vehicle for applying sunscreens due to enhanced water solubility/dispersibility provided by the wsPUs.

In view of these comments, it is respectfully requested that the rejection under § 103(a) be withdrawn.

**Rejection of claims 8-10 and 12-17 under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim and Handbook of Cosmetic Science and further in view of Koch et al and Tanner et al)**

For all the reasons mentioned above, it is respectfully requested that this obviousness rejection be withdrawn.

**Rejection of claim 5 under 35 U.S.C. §103(a) (Anderle in view of Stein, Kim and Handbook of Cosmetic Science and further in view of Gers-Barlag et al)**

For all the reasons mentioned above, it is respectfully requested that this obviousness rejection be withdrawn.

### CONCLUSION

Based on the foregoing remarks it is believed that the claim is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

### CONDITIONAL PETITION FOR EXTENSION OF TIME


If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

### ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
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By \_\_\_\_\_

  
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